

REMARKS

Claims 1-20 remain in this application. Claims 5-8 are withdrawn from consideration. Claims 1-4 and 9-20 are rejected. Claims 1-5, 9, 12-14, 18 and 19 are amended herein to clarify the invention, to broaden language as deemed appropriate and to address matters of form unrelated to substantive patentability issues.

A file history review by applicant using the U.S. Patent and Trademark Office Website in preparation for this response revealed to applicant that a Notice of Abandonment apparently issued in the present case. Applicant never received a copy of this document by mail, and just now discovered that such Notice was indicated as having been mailed on April 19, 2006. Applicant made a timely response to the Office Action mailed October 13, 2005 by filing a Notice of Appeal and a three month Extension request on April 13, 2006 with first class mail certification pursuant to 37 CFR 1.8. Both of these documents were received in the U.S.P.T.O. on April 18, 2006, and were made of record in the case, and the request for extension granted. All fees paid were accepted by the U.S.P.T.O. Therefore, such issuance of a Notice of Abandonment on April 19, 2006 was clearly in error, and applicant respectfully requests that the Examiner withdraw the holding of abandonment, and correct the file

history to reflect same. Notice to that effect in the subsequent action is earnestly solicited.

Applicant herein traverses and respectfully requests reconsideration of the rejection of the claims cited in the above-referenced Office Action.

Claims 19 and 20 are rejected as indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter of the invention as a result of informalities stated in the Office Action. Claim 19 is amended to remove or correct the informality noted in the Office Action. Therefore, reconsideration of the rejection of claims 19 and 20 and their allowance are earnestly requested.

Claims 1-4, 9-12 and 15-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by Willinger et al. (US 6,651,590). Applicant herein respectfully traverses these rejections.

For a rejection to be sustained under §102(e) each and every element of the claimed invention must be disclosed in the cited prior art reference. It is respectfully submitted that the cited reference fails to disclose at least the following features and elements of the present invention as noted herein.

Claim 1 recites in pertinent part the following:

a structural configuration including a portion thereof which comprises an animal access region defined by a structural portion of the toy which the animal is relatively more likely to bite and hold with its mouth by virtue of at least one of enhanced sensory attraction and greater relative physical accessibility, than a remainder of the toy; and

said structural configuration including an other portion defining an animal restricted region, said animal restricted region being defined by another structural portion relatively less likely to be accessed by the pet during play by reason of at least one of less sensory appeal and structural inaccessibility, than said animal access region, said animal restricted region being accessible by a hand of a human user

In the Examiner's Response to Arguments at page 7 of the final Office Action, she states that "[a]lthough the claims are interpreted in light of the specification, limitations from the specification are not read into the claims." Based upon this premise, the Examiner further states that "a fair reading of the claim

language permits the Examiner to interpret that Willinger et al. and DeAngelis disclose an animal restricted region and an animal access region as shown in Figure 22 of Willinger et al. and in Figure 1 of DeAngelis” Claim 1 is therefore amended to positively recite the structural requirements of an animal access region and an animal restricted region, respectively.

As such, and as previously argued, prior to the current amendments which further clarify and define the meaning of the respective regions, the structure, shown in Fig. 22 of Willinger et al. and further described in the written disclosure, does not anticipate the claimed invention of claim 1. The disclosure of Willinger et al. is entirely silent regarding any design feature which would make one region of the depicted structure more or less attractive or accessible to a dog or other animal. Furthermore, if it is the Examiner’s position that such feature is inherent in the depicted configuration, and therefore need not be supported by the written description, applicant respectfully submits that the Examiner has failed to meet her burden by failing to provide evidence in support of her alleged position that an animal would have any particular preference in picking up the toy by any particular region, particularly since it would appear that all parts of the toy are equally accessible by a snout of a dog or other animal. The mere provision of ends of the toy which may be presented in sideways facing orientations with nothing else in the way of teaching of the claimed characteristics which are “sensory-based, i.e., involving

such factors as smell, taste, appearance, surface feel, hardness, etc., and/or ... a structural feature which physically inhibits or discourages access by a dog's mouth to a given one of the regions ... intended to be accessed to a lesser relative degree by the dog or other animal" which at least partially defines the relative terms of "animal access" and "animal restricted" regions, respectively, does not satisfy the metes and bounds of the language of claim 1, and therefore fails to anticipate. In this regard, there is no evidence, teaching, or suggestion in Willinger et al., nor has an adequate showing been made by the Examiner, beyond mere speculation unsupported by disclosure in the reference being cited, tending to establish that an animal would have any preference whatsoever in picking up the toy of Willinger et al. by any particular part thereof more than another. The animal is not inhibited or discouraged by any structure shown in Fig. 22 to gain access to the fully exposed and flush ends. Applicant submits that the dog would simply approach the toy from either end, or tilt its head to the side, and readily grab the radially disposed and spaced apart spokes.

It is respectfully submitted that the Examiner is attributing arbitrary physical characteristics to structural portions of the toy shown in Fig. 22 of Willinger et al., and moreover characteristics wholly unsupported by the disclosure of the cited reference. Simply calling one part of the toy an "animal restricted region" and another part an "animal access region" does not *per se* endow the required physical requirements necessary for the toy to provide the features as claimed, particularly in

light of the current amendments further clarifying, in positive recitations, the structural requirements.

Similarly, claim 4 recites in pertinent part, the following:

at least one structural portion being disposed in a position readily accessible by a mouth of the animal and by which the animal can hold the toy by retaining the at least one structural portion in the mouth;

at least one grip being hand-accessible by the user; and

a shielding portion arranged to at least partially discourage animal access to said at least one grip by inhibiting access of the mouth of the animal thereto, at least a portion of said grip being disposed in an axial position along a toy axis which is disposed inwardly of an axial extent of said shielding portion

As discussed above, the toy and disclosure of Willinger et al. contains no structural portions that could reasonably be described or interpreted as “a shielding portion arranged to at least partially discourage animal access to said at least one grip by inhibiting access of the mouth of the animal thereto, at least a portion of said grip being disposed in an axial position along a toy axis which is disposed inwardly of an axial extent of said shielding portion,” within the context of the claim language as supported by the disclosure. Moreover, the disclosure of Willinger is devoid of teaching or suggestion which makes such claim.

Claim 17 is also directed specifically to a “method of inhibiting user hand contact with animal saliva deposited on a play toy during interactive play by the animal and the user”, and includes the steps of:

providing the toy with an animal access region readily available to gripping in a mouth of the animal; and

providing the toy with an animal restricted region which is less likely to be accessed by the mouth of the animal, said animal restricted region being hand-holdable by the user.

These steps require the toy to have functional characteristics generally analogous to the toy claimed in claim 1, and therefore also fail to be anticipated by the disclosed toy of Willinger et al.. Even if it were possible for the Examiner to successfully equate the structural characteristics of Willinger with the toy of the method claim 17, a new use for an existing structure is not anticipated thereby and may be patentable if such use was not previously taught. *Schering Corp. v. Geneva Pharmaceuticals Inc.*, 68 USPQ2d 1760 (CA FC 2003)

Under 35 U.S.C. §102, anticipation requires that each and every element of the claimed invention be disclosed in the prior art. Furthermore, the prior art reference must be enabling, i.e., it must contain within its four corners a sufficient description to enable one to practice the invention of the rejected claim without undue experimentation or inventive skills. *Akzo N.V. v. U.S. Intern. Trade Com'n*, 1 USPQ2d 1241, 1245 (Fed. Cir 1986). Such is not the case in the present instance, as clearly demonstrated above.

Independent claims 1, 4 and 17 particularly describe and distinctly claim at least one element not disclosed in the cited reference. The remaining rejected claims depend from respective ones of claims 1, 4 and 17 and therefore also contain the element lacking in Willinger et al., noted above. Therefore, reconsideration of the rejection of claims 1-4, 9-12 and 15-18 and their allowance are respectfully requested.

Claims 1-3 and 19-20 are rejected under 35 U.S.C. § 102(e) as being anticipated by DeAngelis. (US D475,487). Applicant herein respectfully traverses these rejections.

As a design patent, the disclosure is limited to a novel decorative appearance. The specification, so directed, is devoid of teaching relating to any functional characteristics of the shape shown. While it is the Examiner's position that the article shown includes the claimed animal access and animal restricted regions, such argument improperly relies upon an assumption of a particular size of the disclosed shape, which is based instead upon using the instant specification as a guide in reading disclosure into DeAngelis which simply does not exist. Indeed, as a design patent, no such mention of size can be present in the specification of DeAngelis, and therefore, one skilled in the art would receive no teaching or suggestion, from the cited reference alone, that the structure shown therein was any larger than that which could be received entirely within an animals mouth, thereby making the item and all portions thereof "animal accessible" and not "animal restricted."

Independent claims 1 and 17 particularly describe and distinctly claim at least one element not disclosed in the cited reference. The remaining rejected claims depend from respective ones of claims 1 and 17 and therefore also contain the element lacking in DeAngelis, noted above. Therefore, reconsideration of the rejection of claims 1-3 and 19-20 and their allowance are respectfully requested.

Claims 13 and 14 are rejected as obvious over Willinger et al. under 35 U.S.C. §103(a). The applicant herein respectfully traverses this rejection.

It is respectfully submitted that the Willinger et al. reference cannot render the rejected claim obvious because the reference does not provide the teaching noted above with respect to the anticipation rejection of claim 4 from which these claims depend. Thus, the reference fails to teach or suggest all the claim limitations. Therefore, reconsideration of the rejection of claims 13 and 14 and their allowance are respectfully requested.

Applicant respectfully requests a three (3) month extension of time to extend the response date to September 18, 2006. A Notice of Appeal was received at the U.S.P.T.O. on April 18, 2006. Please find Check No. 1160 in the amount of \$510.00 to cover the above fee which accompanies a Petition For Extension filed herewith. A Request for Continued Examination (RCE) is being filed concurrently herewith.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Lawrence I. Wechsler", with a stylized flourish at the end.

Lawrence I. Wechsler
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